



5-11-09

1/11  
D.C.

IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE

Patent No. : 7,504,437  
Issue Date : March 17, 2009  
Serial No. : 10/629,108  
Applicants : Kazuo KOYAMA et al.  
Filed : July 28, 2003  
For : BENZYLAMINE ANALOGUES  
Art Unit : 1625  
Examiner : Dr. Taofiq A. SOLOLA  
Docket No. : 03338CIP/HG  
Confirm. No.: 6344  
Customer No.: 01933

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MAIL STOP PETITION  
Commissioner for Patents,  
P.O. Box 1450  
Alexandria, VA 22313-1450

  
Dorothy DeFrancesco

In the event that this Paper is late  
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Account No. 06-1378.

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING  
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**MAIL STOP PETITION**

S I R :

1. This is a request for reconsideration of the patent term  
adjustment of 58 days indicated in the above-identified issued  
patent. It is respectfully requested that applicants be afforded  
a patent term adjustment of 146 days, i.e., an additional 88 days  
of patent term adjustment.

2. This application for patent term adjustment is being filed within two months of the issue date (37 CFR §1.705(d)).

3. Applicants submit herewith a "Statement of the Correct Patent Term Adjustment: Basis Under 37 CFR §1.702 For the Adjustment (37 CFR §1.705(b)(2)(i) and (ii))."

4. The above-identified patent is not subject to a terminal disclaimer (37 CFR §1.705(b)(2)(iii)).

5. As to any circumstances during the prosecution of this patent constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent as set forth in §1.704 (37 CFR §1.705(b)(2)(iv)): there was none (37 CFR §1.705(b)(2)(iv)(B)).

6. The fee set forth in §1.18(e) (\$200), required by 37 CFR §1.705(b)(1), is paid as follows:  
Attached is a Form PTO-2038 in the amount of \$200.

To the extent not tendered by Form PTO-2038 attached hereto, authorization is given to charge any additional fees to Deposit Account No. 06-1378.

It is respectfully requested that this application for patent term adjustment be granted and that a Certificate of Correction be issued to indicate a patent term adjustment of 146 days.

Respectfully submitted,



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RSB/ddf

Encs.: (1) Statement of the Correct Patent Term Adjustment:  
Basis Under 37 CFR §1.702 For the Adjustment (37 CFR  
§1.705(b)(2)(i) and (ii))

(2) Form PTO-2038



**THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

Patent No. : 7,504,437  
Issue Date : March 17, 2009  
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extension of time, and to the extent  
not tendered by check attached hereto, authorization  
to charge the extension  
fee, or any other fee required in  
connection with this Paper to  
Account No. 06-1378.

**STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT:  
BASIS UNDER 37 CFR §1.702 FOR THE ADJUSTMENT  
(37 CFR §1.705(b)(2)(i) AND (ii))**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**MAIL STOP PETITION**

S I R :

1. This statement is being submitted in support of the  
"APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR  
RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED  
PATENT (37 CFR §1.705(d))" to which this statement is attached.

**37 CFR §1.705(b)(2)(i)**

2. The patent term adjustment indicated in the above-identified patent is 58 days. It is respectfully submitted that such indication of patent term adjustment is in error, due to the improper inclusion of a 88 day applicant delay with respect to the following:

(a) applicants' submission of a LETTER RE: NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT, filed December 12, 2008 (which was erroneously assessed by the USPTO as an applicant delay of 23 days); and

(b) applicants' submission of a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008, filed January 12, 2009 (which was erroneously assessed by the USPTO as an applicant delay of 65 days).

It is respectfully submitted that the correct patent term adjustment under 37 CFR §1.702 is 146 days.

**37 CFR §1.705(b)(2)(ii)**

3. The basis on which applicants seek a redetermination of the patent term adjustment is as follows.

a. Applicants received from the USPTO a NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT dated December 9, 2009 ("December 9, 2009 NOTICE"), which stated that applicants' INFORMATION DISCLOSURE STATEMENT ("IDS") filed October 24, 2008 was not compliant with 37 CFR 1.97(d) because the IDS lacked a statement as specified in 37 CFR 1.97(e).

In reply to the December 9, 2009 NOTICE, on December 12, 2009, applicants filed a LETTER RE: NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT ("December 12, 2009 LETTER"). In applicants' December 12, 2009 LETTER, it was stated that applicants' IDS filed on October 24, 2009<sup>8</sup> was filed after the submission of a RCE on October 8, 2008 and before the mailing of a Notice of Allowance on November 18, 2008, and therefore it was timely filed under 37 CFR 1.97(a)(4), which is reproduced as follows:

"(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following periods:

\* \* \*

(4) Before the mailing of a first Office Action after the filing of a request for continued examination under §1.114."

In a USPTO Communication mailed December 31, 2008, the following was stated:

"This is in response to your letter of 12/12/08 contending that the IDS filed 10/24/08 is timely filed, the papers filed on 10/24/08 are timely filed...."

Accordingly, the Examiner agreed with applicants that their October 24, 2008 IDS was timely filed and thus the December 9, 2009 NOTICE was erroneous.

Enclosed is a copy of the Patent Term Adjustment History that was obtained from the USPTO website for the above-identified patent. The Patent Term Adjustment History shows a 23 day applicant delay for the following entry:

| <u>Date</u> | <u>Contents Description</u>   |
|-------------|-------------------------------|
| 12-09-2008  | Miscellaneous Incoming Letter |

Initially it is noted that there was no incoming letter on December 9, 2008, but rather the mailing of the aforesaid USPTO NOTICE on December 9, 2009. It is considered that such 23 day applicant delay was attributed to applicants' December 12, 2009 LETTER.

As shown from the above, applicants' December 12, 2009 LETTER was in reply to the erroneous USPTO December 9, 2009 NOTICE. Accordingly, it is respectfully submitted that the 23 day applicant delay be rescinded.

b. As discussed hereinabove, applicants received a USPTO COMMUNICATION mailed December 31, 2008. In reply to said December 31, 2008 COMMUNICATION, applicants filed on January 12, 2009 a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 31, 2008 ("December 31, 2008 LETTER").

The following was stated in the USPTO COMMUNICATION dated December 31, 2008:

"The papers filed on 10/24/08 are timely filed but they are Office actions sent to an Examiner who issued the actions as well as IDSs previously considered and signed by the same Examiner. Informing the Examiner of his Office actions and/or previous IDSs does not constitute a proper IDS as there is nothing to inform or disclose to the Examiner which he/she didn't know. This has the potential to cause serious confusion with the Office Legal Instrument Examiners and returning an Examiner's action to him/her has the potential of wasting time and delaying prosecution."



The purpose of applicants' December 31, 2008 LETTER was to correct misstatements of the Examiner in the above quoted paragraph, so that the record could be clarified.

The above quoted paragraph refers to copies of Office Actions in copending family member applications that were submitted in applicants' IDS filed on October 24, 2008. In the December 31, 2008 LETTER, it was asserted that the October 24, 2008 IDS was a proper Information Disclosure Statement in that it presented material information, i.e., copies of Office Actions in copending related applications, with respect to patentability. The submission of copies of Office Actions in copending related applications was held to be an appropriate procedure in McKesson Information Solutions, Inc. v. Bridge Medical, Inc., 82 USPQ 2d 1865, 1885 (Fed. Cir. 2007). The following is stated in 82 USPQ 2d 1885:

"Moreover, the MPEP at the time explained that a prosecuting attorney should not assume that [a PTO examiner] retains details of every pending file in his mind when he is reviewing a particular application. MPEP §2001.06(b) (5<sup>th</sup> ed. rev. 3, 1986) (quoting *Armour & Co. v. Swift & Co.*, 466, F.2d 767, 779 [175 USPQ 70] (7<sup>th</sup> Cir. 1972)), and PTO regulations required all disclosures to be in writing, 37 C.F.R. §1.2; see also MPEP §2002.02 (5<sup>th</sup> ed. rev. 3, 1986)."

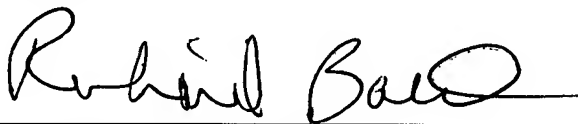
The enclosed copy of the Patent Term Adjustment History for the above-identified patent shows a 65 day applicant delay for the following entry:

| <u>Date</u> | <u>Contents Description</u>   |
|-------------|-------------------------------|
| 1-12-2009   | Miscellaneous Incoming Letter |

The aforesaid 65 day applicant delay was thus assessed for applicants' January 12, 2009 LETTER, which was submitted to the USPTO to correct misstatements in the USPTO COMMUNICATION dated December 31, 2008 and to clarify the record.

It is therefore respectfully submitted that the 65 day applicant delay be rescinded.

Respectfully submitted,



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RSB/ddf

Enclosure: copy of Patent Term Adjustment History  
for Appln. No. 10/629,108 (4 sheets)

10/629,108 BENZYLAMINE ANALOGUES

05-08-  
2009::09:53:18**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/629,108

|                              |            |                                      |     |
|------------------------------|------------|--------------------------------------|-----|
| Filing or 371(c) Date:       | 07-28-2003 | USPTO Delay (PTO) Delay (days):      | 289 |
| Issue Date of Patent:        | 03-17-2009 | Three Years:                         | -   |
| Pre-Issue Petitions (days):  | +0         | Applicant Delay (APPL) Delay (days): | 118 |
| Post-Issue Petitions (days): | +0         | Total PTA (days):                    | 58  |
| USPTO Adjustment(days):      | -113       | Explanation Of Calculations          |     |

**Patent Term Adjustment History**

| Date       | Contents Description  | PTO(Days) | APPL(Days) |
|------------|---|-----------|------------|
| 03-17-2009 | Patent Issue Date Used in PTA Calculation   |           |            |
| 02-13-2009 | Dispatch to FDC   |           |            |
| 02-04-2009 | Issue Fee Payment Verified  |           |            |
| 02-04-2009 | Issue Fee Payment Received  |           |            |
| 02-03-2009 | Mail-Record a Petition Decision of Granted for Patent Term Adjustment after Allowance |           |            |
| 02-03-2009 | Record a Petition Decision of Granted for Patent Term Adjustment after Allowance      |           |            |
| 02-03-2009 | Record a Petition Decision of Granted for Patent Term Adjustment after Allowance      |           |            |
| 02-02-2009 | Adjustment of PTA Calculation by PTO  |           |            |
| 02-02-2009 | Adjustment of PTA Calculation by PTO  |           | 30         |
| 02-02-2009 | Adjustment of PTA Calculation by PTO  |           | ↑          |
| 02-02-2009 | Adjustment of PTA Calculation by PTO  |           | 42         |
| 02-02-2009 | Adjustment of PTA Calculation by PTO  |           | ↑          |
| 02-02-2009 | Adjustment of PTA Calculation by PTO  |           | 41         |
| 01-12-2009 | Miscellaneous Incoming Letter   |           | 65         |
| 12-31-2008 | Mail Miscellaneous Communication to Applicant   |           | ↑          |
| 12-24-2008 | Miscellaneous Communication to Applicant - No Action Count                            |           |            |
| 12-18-2008 | Pubs Case Remand to TC  |           |            |
| 12-09-2008 | Pubs Case Remand to TC  |           |            |
| 12-09-2008 | Miscellaneous Incoming Letter   |           | 23         |
| 12-09-2008 | Mail PUB Notice of non-compliant IDS  |           |            |
| 12-09-2008 | PUB Notice of non-compliant IDS   |           |            |
| 11-25-2008 | Petition Entered  |           |            |
| 11-18-2008 | Mail Notice of Allowance  |           |            |
| 11-18-2008 | Document Verification   |           |            |
| 11-18-2008 | Notice of Allowance Data Verification Completed                                       |           |            |
| 11-14-2008 | Mail-Petition Decision - Dismissed  |           |            |
| 11-14-2008 | Petition Decision - Dismissed   |           |            |
| 10-08-2008 | Reference capture on IDS  |           |            |

|            |   |     |
|------------|---|-----|
| 10-08-2008 | Information Disclosure Statement (IDS) Filed                    |     |
| 10-08-2008 | Date Forwarded to Examiner                                      |     |
| 10-08-2008 | Request for Continued Examination (RCE)                         |     |
| 11-13-2008 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)         |     |
| 10-08-2008 | Information Disclosure Statement considered                     |     |
| 10-08-2008 | Information Disclosure Statement (IDS) Filed                    |     |
| 10-14-2008 | Mail-Record Petition Decision of Granted to Withdraw from Issue |     |
| 10-14-2008 | Record Petition Decision of Granted to Withdraw from Issue      |     |
| 10-08-2008 | Workflow - Request for RCE - Begin                              |     |
| 10-08-2008 | Petition Entered  |     |
| 05-08-2008 | Petition Entered  |     |
| 06-23-2008 | Mail Response to 312 Amendment (PTO-271)                        |     |
| 06-19-2008 | Response to Amendment under Rule 312                            |     |
| 05-14-2008 | Amendment after Notice of Allowance (Rule 312)                  |     |
| 05-20-2008 | Application Is Considered Ready for Issue                       |     |
| 05-15-2008 | Issue Fee Payment Verified                                      |     |
| 05-15-2008 | Issue Fee Payment Received                                      |     |
| 01-24-2008 | Miscellaneous Incoming Letter                                   |     |
| 02-20-2008 | Mail Notice of Allowance  | 155 |
| 06-26-2007 | Document Verification   | ↑   |
| 06-26-2007 | Notice of Allowance Data Verification Completed                 | ↑   |
| 06-13-2007 | Miscellaneous Incoming Letter                                   | ↑   |
| 06-01-2007 | Date Forwarded to Examiner                                      | ↑   |
| 05-18-2007 | Response after Non-Final Action                                 | ↑   |
| 09-21-2006 | Information Disclosure Statement considered                     |     |
| 09-21-2006 | Information Disclosure Statement (IDS) Filed                    |     |
| 06-05-2006 | Information Disclosure Statement considered                     |     |
| 06-05-2006 | Information Disclosure Statement (IDS) Filed                    |     |
| 05-03-2006 | Information Disclosure Statement considered                     |     |
| 05-03-2006 | Information Disclosure Statement (IDS) Filed                    |     |
| 03-21-2007 | Mail Non-Final Rejection  | 82  |
| 03-19-2007 | Non-Final Rejection   | ↑   |
| 09-28-2006 | Information Disclosure Statement considered                     | ↑   |
| 08-29-2006 | Information Disclosure Statement considered                     | ↑   |
| 09-28-2006 | Information Disclosure Statement (IDS) Filed                    | ↑   |
| 09-28-2006 | Information Disclosure Statement (IDS) Filed                    | ↑   |
| 08-29-2006 | Information Disclosure Statement (IDS) Filed                    | ↑   |
| 08-29-2006 | Information Disclosure Statement (IDS) Filed                    | ↑   |
| 02-26-2007 | Date Forwarded to Examiner                                      | ↑   |

|            |  |    |
|------------|--|----|
| 08-29-2006 | Request for Continued Examination (RCE)                    | ↑  |
| 02-26-2007 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)    |    |
| 02-26-2007 | Case Docketed to Examiner in GAU                           |    |
| 08-29-2006 | Workflow - Request for RCE - Begin                         |    |
| 06-22-2006 | Mail Miscellaneous Communication to Applicant              |    |
| 06-19-2006 | Miscellaneous Communication to Applicant - No Action Count |    |
| 05-30-2006 | Mail Notice of Allowance                                   |    |
| 05-25-2006 | Notice of Allowance Data Verification Completed            |    |
| 05-25-2006 | Case Docketed to Examiner in GAU                           |    |
| 05-11-2006 | Date Forwarded to Examiner                                 |    |
| 05-03-2006 | Response after Non-Final Action                            | 30 |
| 05-03-2006 | Request for Extension of Time - Granted                    | ↑  |
| 01-03-2006 | Mail Non-Final Rejection                                   | ↑  |
| 11-16-2005 | Non-Final Rejection  |    |
| 09-16-2005 | Information Disclosure Statement considered                |    |
| 09-16-2005 | Reference capture on IDS                                   |    |
| 09-16-2005 | Information Disclosure Statement (IDS) Filed               |    |
| 09-16-2005 | Information Disclosure Statement (IDS) Filed               |    |
| 09-26-2005 | Date Forwarded to Examiner                                 |    |
| 09-26-2005 | Date Forwarded to Examiner                                 |    |
| 09-16-2005 | Request for Continued Examination (RCE)                    |    |
| 09-26-2005 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)    |    |
| 09-16-2005 | Workflow - Request for RCE - Begin                         |    |
| 06-17-2005 | Mail Final Rejection (PTOL - 326)                          |    |
| 06-16-2005 | Final Rejection  |    |
| 05-26-2005 | Date Forwarded to Examiner                                 |    |
| 05-17-2005 | Response after Non-Final Action                            |    |
| 04-25-2005 | Correspondence Address Change                              |    |
| 02-22-2005 | Mail Non-Final Rejection                                   |    |
| 02-18-2005 | Non-Final Rejection  |    |
| 12-20-2004 | Reference capture on IDS                                   |    |
| 12-20-2004 | Information Disclosure Statement (IDS) Filed               |    |
| 12-20-2004 | Information Disclosure Statement (IDS) Filed               |    |
| 01-15-2005 | Date Forwarded to Examiner                                 |    |
| 12-20-2004 | Response to Election / Restriction Filed                   |    |
| 12-20-2004 | Workflow incoming amendment IFW                            |    |
| 11-19-2004 | Mail Restriction Requirement                               | 52 |
| 11-18-2004 | Requirement for Restriction / Election                     | ↑  |
| 04-29-2004 | IFW TSS Processing by Tech Center Complete                 | ↑  |

|            |  |   |
|------------|--|---|
| 04-29-2004 | Case Docketed to Examiner in GAU   | ⬆ |
| 10-23-2003 | Preliminary Amendment  | ⬆ |
| 04-25-2004 | Case Docketed to Examiner in GAU   | ⬆ |
| 03-02-2004 | IFW TSS Processing by Tech Center Complete   | ⬆ |
| 10-23-2003 | Preliminary Amendment  | ⬆ |
| 10-22-2003 | Information Disclosure Statement (IDS) Filed   | ⬆ |
| 10-22-2003 | Information Disclosure Statement (IDS) Filed   | ⬆ |
| 12-12-2003 | Application Return from OIPE   | ⬆ |
| 12-12-2003 | Application Return TO OIPE   | ⬆ |
| 12-12-2003 | Application Dispatched from OIPE   | ⬆ |
| 12-12-2003 | Application Is Now Complete  | ⬆ |
| 10-22-2003 | Additional Application Filing Fees   | ⬆ |
| 07-28-2003 | Claim Preliminary Amendment  | ⬆ |
| 10-22-2003 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | ⬆ |
| 10-20-2003 | Notice Mailed--Application Incomplete--Filing Date Assigned  | ⬆ |
| 10-11-2003 | Cleared by OIPE CSR  | ⬆ |
| 09-19-2003 | IFW Scan & PACR Auto Security Review   | ⬆ |
| 07-28-2003 | Initial Exam Team nn   | ⬆ |

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